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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,348	12/12/2003	Mustansir M. Banatwala	LOT9-2003-0071-US1 (7321-	3612
46321 7590 04/30/2007 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487			EXAMINER DIVECHA, KAMAL B	
			ART UNIT 2151	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/734,348

Applicant(s)

BANATWALA ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1-19 are pending in this application.

Claims 4, 11 and 18 are cancelled.

**Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 15, 2007 has been entered.

**Response to Arguments**

Applicant's arguments filed in association with a Request for Continued Examination (RCE) with respect to claims 1-19 have been fully considered but are moot in view of the new ground(s) of rejection, as presented herein, and, as necessitated by the substantial amendments, which has affected the scope thereof.

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-3, 5-10, 12-17 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/744,302 (hereinafter '302) in view of Estrada (US 6,996,780 B2).

Claims 1-15 of co-pending application '302 explicitly and/or inherently discloses each and every limitation of claims 1-3, 5-7,

For example: claims 1, 3, 4 and 7 of '302 discloses a named collaborative space with roles, membership, resources such as business components, messaging tools and creating instances of the named collaborative spaces, similar to claim 1-3 of present application (except for provisionable named collaborative space).

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However, '302 does not disclose the process of providing provisionable named collaborative space (i.e. to base a named collaborative space on a previous named space in a manner which may require little or no customization).

Estrada explicitly discloses the process of creating place type from which new places are created in collaboration space (see claims 1-10).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify '302 in view of Estrada in order to provide a provisionable named collaborative space.

One of ordinary skilled in the art would have been motivated because it would have provided an environment where web applications are instantly created, instantly archived, team and project oriented, easy to use, created, accessed and administered via the web, reusable, and extensible (Estrada, col. 3 L37-50).

This is a provisional obviousness-type double patenting rejection.

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2. Claims 1-3, 5-10, 12-17 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,996,780 B2 in view of Moser et al. (hereinafter Moser, US 2004/0107249 A1).

'780 Patent discloses a collaborative computing method for establishment of a named collaborative space comprising the process of providing a templatable and provisionable named collaborative space to serve a basis for establishment instances of named collaborative spaces, similar to an invention disclosed in the present application.

Moser, on the other hand, explicitly discloses each and every limitations of the claimed invention, as evidenced by the detailed mappings presented below (See 35 U.S.C. 102(e) rejection presented below).

Therefore, the combination of '780 patent and Moser clearly results in an invention disclosed in the present application.

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**Specification**

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claims, i.e. lack of written description. See MPEP § 2163.

**Claim 1 recites:**

A collaborative computing method...provisioning an instance of the templatable and provisionable named collaborative space...providing a plurality of business process component instances for management within the provisioned instance of the named collaborative space; and, managing a common lifecycle for each of the provisioned instance of the named collaborative space and the business process components within the provisioned instance of the named collaborative space.

**Claim 5 recites:**

The method of claim 1, wherein the provisioned instance of the templatable and provisionable named collaborative space is provisionable from other provisioned of named collaborative space.

In response filed February 15, 2007 (page 7), applicant directed to the original specification, page 7, [0016], for supporting the claim amendments.

The aforementioned paragraph is reproduced herein:

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[0016] The present invention is method and system for the establishment of a named collaborative space (referred to herein as "NCS") in a collaborative computing environment. The present invention provides a templatable and provisionable approach to facilitate the deployment of collaborative computing environments and places.

Templatable as used herein refers to the ability of a collaborative computing community developer or user to create a named collaborative space which can serve as a model for other named spaces. Deploying subsequent named spaces using the method and system of the present invention involves merely calling up an existing template and arranging it to fit the needs of the community. Provisionable as used herein refers to the ability of a collaborative computing community developer or user to base a named collaborative space on a previous named space in a manner which may require little or no customization.

The paragraph above clearly fails to disclose, teach or suggest the process of provisioning an instance of the templatable and provisionable named collaborative space.

The terms provisioning and provisionable are distinct.

Furthermore, if there is no provisioning, then there is no provisioned instance of the named collaborative space as disclosed in the context of the claim, and if there is no provisioned instance of the named collaborative spaces, then, there is no provisioned instance of the templatable and provisionable named collaborative spaces from other provisioned instances of the named collaborative space.

Thus, the originally filed specification fails to teach, disclose or suggest the process as disclosed in claims 1 and 5.

Hence, the above claimed limitations presents the subject matter situations and was not described in the specification in such a way as to reasonably convey to one skilled in the relevant



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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 5-10, 12-17 and 19 are rejected under 35 U.S.C. 112, first paragraph, for the same reasons as set forth in specification above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5-10, 12-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 1 recites:**

A collaborative computing method...provisioning an instance of the templatable and provisionable named collaborative space...providing a plurality of business process component instances for management within the provisioned instance of the named collaborative space; and, managing a common lifecycle for each of the provisioned instance of the named collaborative space and the business process components within the provisioned instance of the named collaborative space.

In the context of the claim, the functionality “managing a common lifecycle” is unclear.

In fact, the term “common lifecycle” is unclear.

The term lifecycle may incorporate different functions when used in the relevant art.

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Applicant is advised to clearly recite the functionality encompassed by the term “common lifecycle”.

Further, the term “other” in claim 5 renders the claim indefinite because it is unclear which one of the provisioned instances of named collaborative spaces the claim is referring to.

Claims 2-3, 6-10, 12-17 and 19 are rejected for the same reasons as set forth in claims 1 and 5.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-10, 12-17 and 19 are rejected under 35 U.S.C. 102(e) as anticipated by Moser et al. (hereinafter Moser, US 2004/0107249 A1).

As per claim 1, Moser explicitly discloses a collaborative computing method for the establishment of a named collaborative space (pg. 1 [0004-0008]), the method comprising:

providing a templatable (based on template) and provisionable (customizable) named collaborative space to server as a basis for establishment instances of named collaborative spaces, the templatable and provisionable named collaborative space defining work place within the collaborative computing environment and configured to manage a plurality of business process components disposed within an instance of the named space in a one-to-many relationship (pg. 2 [0017], [0021], pg. 3 [0030], [0031], pg. 4 [0035], [0040], [0042], pg. 5 [0053], pg. 6 [0054], fig. 1-6);

provisioning an instance of the templatable and provisionable named collaborative space (fig. 3-6, pg. 5 [0053], pg. 6 [0054]);

identifying a membership set for the named collaborative space, the membership set including one or more members (fig. 3 item #106, 110, pg. 4 [0040-0043], fig. 4);

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providing a plurality of business component instances for management within the provisioned instance of the named collaborative space (fig. 4, pg. 2 [0021], pg. 3 [0027]); and, managing a common lifecycle for each of the provisioned instance of the named collaborative space and the business process components within the provisioned instance of the named collaborative space (fig. 1, fig. 4, pg. 3 [0027-0029], fig. 3).

As per claim 2, Moser discloses the process wherein the business process component instances are business instance portlets (fig. 4, pg. 2 [0021], pg. 3 [0027]).

As per claim 3, Moser discloses the process wherein the members of membership set for the collaborative space are assigned a role, the role defining access and permission privileges to the at least one business process (pg. 2 [0023-0024], pg. 3 [0031-0032], pg. 5 [0049], pg. 6 [0054], fig. 3-6).

As per claim 5, Moser discloses the process wherein provisioned instance of the templatable and provsionable named collaborative space is provisionable from other provisioned instances of the named collaborative spaces (pg. 3 [0026], pg. 4 [0039]).

As per claim 6, Moser discloses the process of transferring information between the business component instance and the named collaborative space, the information being transferred using an enterprise java bean (pg. 2 [0021-0023], pg. 6 [0059]).

As per claim 7, Moser discloses the process further including assigning a policy to the named space (pg. 3 [0031]).

As per claims 8-10, 12-17 and 19, they do not teach or further define over the limitations in claims 1-3, 5-7. Therefore claims 8-10, 12-17 and 19 are rejected for the same reasons as set forth in claims 1-3, 5-7.

**Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Stewart et al., US 7,051,071 B2: Workflow Integration system for Enterprise wide electronic collaboration.
- b. Stewart et al., US 7,051,072 B2: Method for providing real-time conversations among business partners.
- c. Thompson et al., US 2002/0075303 A1: Method and system for creating a virtual team environment.


**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kamal Divecha  
Art Unit 2151  
April 24, 2007.

  
**ZARNI MAUNG**  
**SUPERVISORY PATENT EXAMINER**